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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,329	05/11/1999	Mark O Worthington	BURST-3-CIP1	1107

7590

02/11/2003

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EXAMINER

CHEU, CHANGHWA J

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 02/11/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/311,329

Applicant(s)

WORTHINGTON ET AL.

Examiner

Jacob Cheu

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-92 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) ~~(to a provisional application)~~.
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-34, 36-37, 49 and 85-90, drawn to a trackable optical disc, classified in class 422, subclass 119.
 - II. Claims 35, 38-48 and 90, drawn to an optical disc, classified in class 422, subclass 82.05.
 - III. Claims 50-66 and 86, drawn to a trackable optical disc, classified in class 369, subclass 275.1.
 - IV. Claims 67-76 and 91-92, drawn to a method of making a trackable optical disc, classified in class 29, subclass 854.32.
 - V. Claims 77-81 and 92, drawn to a method of making a trackable optical disc, classified in class 432, subclass 297.
 - VI. Claims 82-84, drawn a method of segregating tracking a signals from signals generated by readable nonoperational features disposed upon an optical disc, classified in class 346, subclass 17.
1. Inventions I and (II-III) are patentably unrelated and distinct. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the feature of comprising a first reflective surface having an attribute trackable by an optical disc reader in invention I, is not required by the claims of inventions II and III. Likewise, the feature of comprising a laser-refracting cover, wherein said cover further focuses the laser of said optical disc reader on said disc's first reflective surface in invention II, is not required by the claims of inventions I and III. The feature of comprising a second reflective surface in invention III, is not required by the claims of inventions I and II.

2. Inventions IV and (V and VI) are patentably unrelated and distinct. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the feature disposing a data-encoding nonoperational feature on an optical disc readably with a trackable attribute of said disc in invention IV, is not required by the claims of the inventions V and VI. The feature of disposing a data-encoding nonoperational feature on the laser-distal side of a laser-refracting cover in invention V, is not required by the claims of inventions IV and VI. The feature of disposing nonoperational feature confocally with a trackable attribute that produces minimal variation in the HF signal in invention VI, is not required by the claims of inventions IV and V.
3. Inventions (I-III) and (VI-V) are related as product made and processes of making. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different product or by hand, or (2) the product as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this instant case, the inventions I-III can be viewed as common CD player and be practiced by a material different method of making other than inventions VI-V. Therefore, inventions (I-III) and (VI-V) are patentably distinct.

The inventions are distinct, each from the other because of the following reasons:

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for one group is not required for the other, therefore restriction for examination purposes as indicated is proper.
5. A telephone call was made to Mr. Guy Smith on January 10, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Art Unit: 1641

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Cheu whose telephone number is 703-306-4086. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3399.

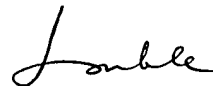
Jacob Cheu



Examiner

Art Unit 1641

January 29, 2003



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1000

02/07/03